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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,165	09/04/2003	Deryck J. Williams	12557-021001	5413
26161	7590	08/29/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PAK, JOHN D	
		ART UNIT	PAPER NUMBER	
		1616		

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/655,165	WILLIAMS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JOHN PAK	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-84 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) 1-84 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

Claims 1-84 are pending in this application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, claims 1-74, drawn to nematicidal composition and method wherein the active agent has the carboxylic acid or ester structure,  $R_1-O-C(O)-R_2$ , wherein  $R_2$  is a  $C_{15-19}$  carbon chain having a cis or trans double bond between the 9<sup>th</sup> and 10<sup>th</sup> carbon atom counting from the carbonyl carbon and either (i) a triple bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons or (ii) single or double bond between the 12<sup>th</sup> and 13<sup>th</sup> carbon and at least one substituent at one or both of the 12<sup>th</sup> or 13<sup>th</sup> carbons, classified in multiple subclasses in class 514, such as subclasses 506+ and 558+, depending on various substituents.

Group II, claims 1-74, drawn to nematicidal composition and method wherein the active agent has the amide structure,  $R_1-NH-C(O)-R_2$ , wherein  $R_2$  is a  $C_{15-19}$  carbon chain having a cis or trans double bond between the 9<sup>th</sup> and 10<sup>th</sup> carbon atom counting from the carbonyl carbon and either (i) a triple bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons or (ii) single or double bond between the 12<sup>th</sup> and 13<sup>th</sup> carbon and at least one substituent at one or both of the 12<sup>th</sup> or 13<sup>th</sup> carbons, classified in multiple subclasses in class 514, such as subclasses 613+, depending on various substituents.

Group III, claims 1-74, drawn to nematicidal composition and method wherein the active agent has the ketone/aldehyde structure,  $R_1-C(O)-R_2$ , wherein  $R_2$  is a  $C_{15-19}$  carbon chain having a cis or trans double bond between the 9<sup>th</sup> and 10<sup>th</sup> carbon atom

counting from the carbonyl carbon and either (i) a triple bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons or (ii) single or double bond between the 12<sup>th</sup> and 13<sup>th</sup> carbon and at least one substituent at one or both of the 12<sup>th</sup> or 13<sup>th</sup> carbons, classified in multiple subclasses in class 514, such as subclasses 675+ and 693+, depending on various substituents.

Group IV, claims 75-78, drawn to a feed for non-human vertebrate comprising a feed + a nematicidal compound + aqueous surfactant.

Group V, claims 79-80, drawn to a nematicidal composition wherein the active agent has the structure, R<sub>1</sub>-O-C(O)-R<sub>3</sub>-X-Y-R<sub>4</sub>, wherein R<sub>3</sub> is a C<sub>11</sub> carbon chain having a cis double bond between the 9<sup>th</sup> and 10<sup>th</sup> carbon, X and Y are substituted or unsubstituted methyl or S, provided at least one of X and Y is S, and R<sub>4</sub> is a substituted or unsubstituted C<sub>2-6</sub> alkyl, alkenyl or alkynyl group, classified in multiple subclasses in class 514, such as subclasses 506+ and 558+, depending on various substituents.

Group VI, claims 79-80, drawn to a nematicidal composition wherein the active agent has the structure, R<sub>1</sub>-NH-C(O)-R<sub>3</sub>-X-Y-R<sub>4</sub>, wherein R<sub>3</sub> is a C<sub>11</sub> carbon chain having a cis double bond between the 9<sup>th</sup> and 10<sup>th</sup> carbon, X and Y are substituted or unsubstituted methyl or S, provided at least one of X and Y is S, and R<sub>4</sub> is a substituted or unsubstituted C<sub>2-6</sub> alkyl, alkenyl or alkynyl group, classified in multiple subclasses in class 514, such as subclasses 613+, depending on various substituents.

Group VII, claims 79-80, drawn to a nematicidal composition wherein the active agent has the structure, R<sub>1</sub>-C(O)-R<sub>3</sub>-X-Y-R<sub>4</sub>, wherein R<sub>3</sub> is a C<sub>11</sub> carbon chain having a

cis double bond between the 9<sup>th</sup> and 10<sup>th</sup> carbon, X and Y are substituted or unsubstituted methyl or S, provided at least one of X and Y is S, and R<sub>4</sub> is a substituted or unsubstituted C<sub>2-6</sub> alkyl, alkenyl or alkynyl group, classified in multiple subclasses in class 514, such as subclasses 675+ and 693+, depending on various substituents.

Group VIII, claims 81-84, drawn to a nematicidal composition wherein the active agent has the carboxylic acid or ester structure, R<sub>1</sub>-O-C(O)-R<sub>2</sub>, wherein R<sub>2</sub> is a C<sub>15-19</sub> carbon chain having a single bond between the 9<sup>th</sup> and 10<sup>th</sup> carbons and either (i) a triple bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons or (ii) either a single or double bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons and at least one substituent at one or both of the 12<sup>th</sup> and 13<sup>th</sup> carbons, classified in multiple subclasses in class 514, such as subclasses 506+ and 558+, depending on various substituents.

Group IX, claims 81-84, drawn to a nematicidal composition wherein the active agent has the amide structure, R<sub>1</sub>-NH-C(O)-R<sub>2</sub>, wherein R<sub>2</sub> is a C<sub>15-19</sub> carbon chain having a single bond between the 9<sup>th</sup> and 10<sup>th</sup> carbons and either (i) a triple bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons or (ii) either a single or double bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons and at least one substituent at one or both of the 12<sup>th</sup> and 13<sup>th</sup> carbons, classified in multiple subclasses in class 514, such as subclasses 613+, depending on various substituents.

Group X, claims 81-84, drawn to a nematicidal composition wherein the active agent has the ketone/aldehyde structure, R<sub>1</sub>-C(O)-R<sub>2</sub>, wherein R<sub>2</sub> is a C<sub>15-19</sub> carbon

chain having a single bond between the 9<sup>th</sup> and 10<sup>th</sup> carbons and either (i) a triple bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons or (ii) either a single or double bond between the 12<sup>th</sup> and 13<sup>th</sup> carbons and at least one substituent at one or both of the 12<sup>th</sup> and 13<sup>th</sup> carbons, classified in multiple subclasses in class 514, such as subclasses 675+ and 693+, depending on various substituents.

The inventions listed as Groups I to X are distinct, each from the others, for the following reasons. Groups I-III and V-X are distinct by virtue of their distinct active agents, which are structurally divergent from each other, as set forth above. As for Group IV, this invention requires the presence of a feed suitable for a non-human vertebrate and reads on in vivo application of the various fatty acid based compounds as a feed additive. The invention is thereby distinct over the other inventions.

The search and examination of more than one invention group would place an undue burden on the Examiner if the restriction were not required. The Examiner only has so many hours to search and examine one application and this application is directed to multiple distinct inventions that cannot be searched together. The various inventions are distinct enough that a search for one invention would be incomplete for the other inventions. The search for just one of the inventions would already place sufficient burden on the Examiner due to the complexity of the structures and the painstaking effort it would take to distinguish all the structural features of prior art fatty acid-based compounds vis-a-vis the claimed compounds. Further, there is no way to

efficiently form a structural query that will run a database search for more than one invention group.

Therefore, for the reasons of distinctness and undue burden, the restriction requirement as set forth above is deemed to be proper.

A telephone call was made to Ms. Meiklejohn on 8/23/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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